

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jaques JOLIVET et al.

Examiner: Cybille Delacroix-Muirheid

Serial No.: 10/806,336

Group Art Unit: 1614

Filed: March 23, 2004

Title: METHOD FOR ADMINISTRATION OF TROXACITABINE

TECHNOLOGY CENTER 1600

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PETITION FOR WITHDRAWAL OF FINALITY
OF OFFICE ACTION UNDER 37 C.F.R. §1.181**

SIR:

This is a petition requesting the Commissioner, through the Honorable Group Director, to reverse the Examiner's decision in making the Office Action of September 11, 2007 a Final Office Action.

Statement of Facts

On December 19, 2006, the Examiner issued an Office Action which, *inter alia*, rejected claims 1, 3-15, and 17-60 under 35 USC 103(a) as allegedly being obvious in view of the abstract by De Bono et al. in combination with Chu et al. (US 5,817,667) and Benet et al. See pages 11-15 of the December 19, 2006 Office Action. This was the first time that a rejection based on this combination of prior art references was presented during the prosecution of the instant application.

In that same December 19, 2006 Office Action, the Examiner presented an obviousness double-patenting rejection in view of Gourdeau (US 6,630,480) in combination with Gourdeau (US 6,747,036), Gourdeau (US 6,800,639), Chu et al. (US 5,817,667), and the article by De Bono et al. See pages 3-7 of the December 19, 2006 Office Action. This was

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the first time that a rejection based on this combination of references was presented during the prosecution of the instant application.

Additionally, the December 19, 2006 Office Action presented a further rejection, i.e., an obviousness double-patenting rejection in view of Serial No. 10/824,563 in combination with Gourdeau (US 6,630,480), Gourdeau (US 6,747,036), Gourdeau (US 6,800,639), Chu et al. (US 5,817,667), and the article by De Bono et al. See page 8 of the December 19, 2006 Office Action. This was the first time that a rejection based on this combination of prior art references was presented during the prosecution of the instant application.

On September 11, 2007, the Examiner issued a Final Office Action. In that Final Office Action, claims 1, 3-15, and 17-60 were finally rejected under 35 USC 103(a) as allegedly being obvious in view of the abstract by De Bono et al. in combination with Chu et al. (US 5,817,667) and Benet et al.

However, as presented in the Office Action of September 11, 2007, the rejection now further referred to the reference **Lokich et al.** As noted above, the first time a rejection in view of view of De Bono et al., Chu et al., and Benet et al. was presented was in the December 19, 2006 Office Action. As presented in the December 19, Office Action, the original version of the rejection makes absolutely no mention of the reference Lokich et al.

Conversely, in the rejection in view of De Bono et al., Chu et al., and Benet et al. as presented in the Office Action of September 11, 2007, the Lokich et al. reference figures prominently. Lokich et al. is discussed in detail at pages 5-7 of the Office Action. Moreover, it is clear that Lokich et al. is being relied on to allegedly overcome a discrepancy in the previous combination of De Bono et al., Chu et al., and Benet et al. regarding the duration of the infusion administration. See the Examiner's rebuttal to applicants' traversal of the rejection under 35 USC 103(a) at pages 10-11.

At page 18, the Examiner states that the arguments responding to applicants' arguments presented previously in the Office Action (which includes the arguments based on Lokich et al. at page 5-7 and 10-11) are incorporated into the 103 rejection. Furthermore, the 103 rejection expressly cites the Lokich et al, reference with respect to infusion duration (see text bridging pages 19-20 of the Office Action). Moreover, the rejection again specifically relies on Lokich et al. in making the conclusion of obviousness. See middle of page 24 of the Office Action.

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The Office Action of September 11, 2007 also restates the obviousness double-patenting rejection in view of Gourdeau (US 6,630,480) in combination with Gourdeau (US 6,747,036), Gourdeau (US 6,800,639), Chu et al. (US 5,817,667), and the article by De Bono et al. It is evident from the Office Action that this rejection also relies on the disclosure of the newly applied reference, Lokich et al. See the discussion of Lokich et al. at pages 5-7 of the September 11, 2007, which is a rebuttal to the arguments presented by applicants with respect to the obviousness double-patenting rejections. See also the discussion of Lokich et al. at page 14 of the Office Action of September 11, 2007.

Additionally, the Office Action presented a third rejection, i.e., an obviousness double-patenting rejection in view of Serial No. 10/824,563 in combination with Gourdeau (US 6,630,480), Gourdeau (US 6,747,036), Gourdeau (US 6,800,639), Chu et al. (US 5,817,667), and the article by De Bono et al. It is evident from the Office Action that this rejection also relies on the disclosure of the newly applied reference, Lokich et al. See the discussion of Lokich et al. at pages 5-7 of the September 11, 2007, which is a rebuttal to the arguments presented by applicants with respect to the obviousness double-patenting rejections.

Summary of Arguments

As can be seen from the above, all three rejections presented in the Final Office Action rely on the newly cited reference, Lokich et al. Discussion of the Lokich et al. figures prominently in the arguments presented in the Office Action, as can be seen by the amount of text devoted to this reference.

Additionally, it is evident from the discussion in the September 11, 2007 Office Action of applicants' arguments and the Lokich et al. reference, that Lokich et al. is specifically being relied on to allegedly overcome a deficiency in the previous combination of De Bono et al., Chu et al., and Benet et al. regarding the duration of the infusion administration.

In the Advisory Action issued February 12, 2008, the Examiner denies applicants' request for withdrawing the Finality of the September 11, 2007 Office Action. The Examiner argues that Lokich et al. is only cited as evidence of the general state of the art, citing page 24, second full paragraph of the September 11, 2007 Office Action.

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It is correct that the paragraph cited by the Examiner refers to Lokich et al. as being evidence. However, this is not determinative. All of the references cited in the rejections are “evidence” that allegedly support the rejection. The extensive discussion of the Lokich et al. reference in the Office Action clearly demonstrates that the Examiner is relying on this reference to support the rejections, not merely show the state of the art.

Further, the Examiner clearly indicated in the Office Action when a reference was being relied on solely to demonstrate the state of the art. See the first full paragraph on page 24 of the September 11, 2007 Office Action where the examiner states that Weitman S, et al. “is cited only to show the state of the art.”

It is noted that the September 11, 2007 Office Action alleges that applicants’ amendment necessitated **the new ground of rejection**. Firstly, as can be seen from the above, the Office Action does not expressly state a new ground of rejection, but does in fact present one. Secondly, Lokich et al. is relied on to address a deficiency in the previous prior art rejection, not any new aspect added to the claims by amendment. Finally, the only amendments made to the claims in the Reply filed May 14, 2007, were to dependent claims 4, 18, and 49. These claims were amended to state that the cancer is leukemia selected from a specified group, and applicants pointed out that these amendments did not narrow the scope of the claims, and no new matter was added.

Conclusion and Requested Relief

In view of the above remarks, it is respectfully submitted that the Examiner’s action in making Final the Office Action of September 11, 2007 was improper. Applicants respectfully request that the Examiner’s action be reversed.

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The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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Attorney Docket No.:STROMIX-8

Date: March 10, 2008

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